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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,313	01/23/2002	Chad Stevens	10013604-01	8004

7590 11/05/2003
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

OSORIO, RICARDO

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 11/05/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,313

Applicant(s)

STEVENS ET AL.

Examiner

RICARDO L OSORIO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 10 is objected to because of the following informalities: A grammatical error is found in claim 10, line 7, after surface. After the word surface, there should be a --,--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7, 9, 10, 12, 13, 15, 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Comiskey et al. (6,473,072).

Regarding claim 1, Comiskey teaches of a whiteboard apparatus (Fig. 12a, reference character 120, and col. 14, lines 50-52) comprising:
an electronic paper display device configured to display an image (col. 13, lines 58-61); and a writing surface (Fig. 12b, reference character 129) arranged in superimposed relationship with the electronic paper display device (col. 14, lines 47-49. Note that the protecting layer or coating is the superimposed writing surface).

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Regarding claim 2, Comiskey teaches of the electronic paper display device comprising: a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Regarding claim 3, Comiskey teaches that the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 4, Comiskey further teaches of a network interface device configured for communication with a communication network and wherein the image displayed on the electronic paper display is received via the communication network (col. 16, lines 48-52 and 60-67. Note that the communications device and appropriate logic circuitry used to download information from the web or, internet, requires a network interface).

Regarding claim 5, Comiskey further teaches of the display device configured to display a reference image over which a user may write on the writing surface (col. 14, lines 47-53. Any image over which the user may write constitutes a reference image).

Regarding claim 7, Comiskey further teaches of a memory configured to store one or more images to be displayed on the electronic paper display device (col. 17, lines 3-6).

Regarding claim 9, Comiskey further teaches of a scanning device configured to convert a document to an electronic image to be displayed on the electronic paper display device (col. 17, lines 2-6).

Regarding claim 10, Comiskey teaches of a method comprising the steps of :
Providing an electronic paper display device configured to display an image (col. 13, lines 58-61) on a whiteboard (Fig. 12a, reference character 120, and col. 14, lines 50-52); arranging a writing surface (Fig. 12b, reference character 129) in superimposed relationship with the electronic paper display device (col. 14, lines 47-49. Note that the protecting layer or coating is the superimposed writing surface); and displaying an image on the electronic paper display device over which a user may write on the writing surface (col. 14, lines 47-53).

Regarding claim 12, Comiskey further teaches of downloading the reference image to be displayed on the electronic paper display device (col. 16, lines 48-52 and 60-67).

Regarding claim 13, Comiskey further teaches than the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 15, Comiskey further teaches of storing the image to be displayed on the electronic paper display device (col. 17, lines 2-6).

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Regarding claim 16, Comiskey further teaches of scanning the image from a document (col. 17, lines 2-3).

Regarding claim 18, Comiskey further teaches that the electronic display device comprises: a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 8, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey (see rejection under 35 U.S.C. 102(e) above) in view of Chery et al (6,177,927).

Regarding claim 6, Comiskey fails to teach that the reference image comprises a Cartesian plane.

Chery does not specifically teach of a reference image comprising a Cartesian plane. However, Chery teaches of a large variety of background, or reference, images over which a user may write

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on the writing surface which may include a spreadsheet, blueprints, text, graphs, graphics (see Chery, col. 24, lines 30-50). Also, Chery teaches that images for the background images can be created with graphics programs such as VISIO, CAD programs, or other programs used to make documents, and also, that the reference image can be an image from a webpage (see Chery, col. 24, line 62-col. 25, line 5, and col. 25, lines 33-43). Finally, Chery teaches of a Cartesian coordinate that is transposed on the writing surface; the corners of the monitor image area are defined as (0,0), (0,H), (W,0) and (W,H) (see Chery, Figs. 11B and 11C, and col. 49, lines 47-63). Although, Chery is silent as to if the corner coordinates of the monitor image area are displayed, it can be clearly appreciated that there is nothing preventing Chery from having a reference image comprising a Cartesian plane.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a reference image showing a Cartesian plane, as taught by Chery, in the device of Comiskey, so that the user can write a stroke on the writing surface and know the precise stylus location as a set of Cartesian coordinates (see Chery, col. 49, line 66-col. 50, line 2). Also, it is well known in the art of graphics that a program such as CAD can be used to create any desired graphical image such as a Cartesian coordinate, a graph, etc.

Regarding claim 8, Comiskey fails to further teach of a user interface device configured to enable a user to select one of the images stored in memory to be displayed on the electronic paper display device.

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Chery teaches of a user interface device configured to enable a user to select one of the images stored in memory to be displayed on an electronic whiteboard display device (col. 62, lines 15-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the user interface device, as taught by Chery, in the device of Comiskey because user interface devices are conventionally known to be used in computer display devices of any kind, including electronic whiteboards, to select from a menu of saved images thereby easily accessing the desired saved image.

Regarding claim 11, Comiskey fails to teach of selecting the image to be displayed on the electronic paper display device.

Chery teaches of selecting the image to be displayed on an electronic whiteboard display device (col. 62, lines 15-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the user interface device, as taught by Chery, in the device of Comiskey because user interface devices are conventionally known to be used in computer display devices of any kind, including electronic whiteboards, to select from a menu of saved images thereby easily accessing the desired saved image.

Regarding claim 14, Comiskey fails to teach that the reference image comprises a Cartesian plane.

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Chery does not specifically teach of a reference image comprising a Cartesian plane. However, Chery teaches of a large variety of background, or reference, images over which a user may write on the writing surface which may include a spreadsheet, blueprints, text, graphs, graphics (see Chery, col. 24, lines 30-50). Also, Chery teaches that images for the background images can be created with graphics programs such as VISIO, CAD programs, or other programs used to make documents, and also, that the reference image can be an image from a webpage (see Chery, col. 24, line 62-col. 25, line 5, and col. 25, lines 33-43). Finally, Chery teaches of a Cartesian coordinate that is transposed on the writing surface; the corners of the monitor image area are defined as (0,0), (0,H), (W,0) and (W,H) (see Chery, Figs. 11B and 11C, and col. 49, lines 47-63). Although, Chery is silent as to if the corner coordinates of the monitor image area are displayed, it can be clearly appreciated that there is nothing preventing Chery from having a reference image comprising a Cartesian plane.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a reference image showing a Cartesian plane, as taught by Chery, in the device of Comiskey, so that the user can write a stroke on the writing surface and know the precise stylus location as a set of Cartesian coordinates (see Chery, col. 49, line 66-col. 50, line 2). Also, it is well known in the art of graphics that a program such as CAD can be used to create any desired graphical image such as a Cartesian coordinate, a graph, etc.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey (see above) in view of applicant's admitted prior art (APA, hereafter).

Regarding claim 17, Comiskey fails to teach of printing the image displayed on the electronic paper display and the contents of the writing surface.

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APA teaches of printing the combined result of the image displayed on the electronic paper display and the contents of the writing surface (see application, page 2, lines 2-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the combined image, as taught by APA, in the device of Comiskey because it is well known in the art of electronic whiteboards to integrate a printer which can print both original images and updated images, for example, to provide an updated hard copy of the lecture or conference to all the participants.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is (703) 305-2248. The examiner can normally be reached on Mon-Thu from 7:00 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached at 305-4938.

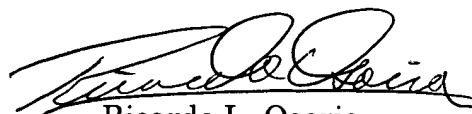
Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to: (703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Ricardo L. Osorio
Examiner
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RLO

November 3, 2003